

## **REMARKS**

### **I. Status of the Claims**

Upon entry of this amendment, claims 30-34 and 36-71 are pending. No new matter has been added. Applicants note with appreciation the allowability of claim 35. Since Applicants have cancelled claim 35 in favor of claim 36, which the Examiner indicates is duplicative, Applicants presume that claim 36 is now allowable.

### **II. Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claim 36 was rejected under 35 U.S.C. § 112, second paragraph for allegedly being a duplicate of claim 35. Applicants have cancelled claim 35 via this amendment. The Examiner's indication of allowability of claim 35 should now apply to claim 36.

### **III. Rejection Under 35 U.S.C. § 103(a)**

Claims 30-34 and 37-71 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dubief et al. (USP 5,700,456) ("Dubief") in view of the International Cosmetic Ingredient Dictionary. The Office has acknowledged that Dubief does not disclose specifically the instantly claimed amphiphilic polymer in compositions containing both a dye and oxidant, nor does Dubief disclose the relative proportions of the instantly claimed amphiphilic polymer to dye/oxidant, nor does Dubief disclose multi-compartment kits as claimed herein. Office Action of October 24, 2001 at pages 3-4.

Nevertheless, the Office has argued that the instant claims would have been obvious because "such compositions and processes fall within the scope of those taught by Dubief." Office Action at page 4. Further, the Office has argued that since

Dubief discloses NATROSOL PLUS (i.e., cetyl hydroxyethylcellulose, as taught by the International Cosmetic Dictionary) as a preferred thickener, there would have been the requisite motivation to select and add that thickener to a hair dyeing composition and optimization of amounts would have been obvious. *Id.* In addition, the Office has argued that the instantly claimed multi-compartment kits would have been obvious because Dubief discloses separate oxidant and dye-containing compositions prior to application. Office Action at page 5. Applicant respectfully disagrees and traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, the reference(s) must teach or suggest all the claim limitations. Finally, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See MPEP § 2143 and cases cited therein. For at least the reason that the references would have provided no motivation to reach Applicants' invention, the rejection is improper.

Dubief is directed primarily to the combination of ceramides or glycosceramides with certain cationic polymers. The combination produces a synergistic effect as regards wet disentangling of hair. See Dubief at column 1, lines 29-34. A variety of other ingredients may be added to Dubief's combination. These include, *inter alia*, surfactants, preservatives, sequestering agents, emollients, foam modifiers, acidifying agents, alkalizing agents, hydrating agents, anti-dandruff agents, anti-seborrheic

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agents, sunscreen agents, proteins, vitamins, hydroxy acids, salts, detoxifying agents, permanent-waving reducing or fixing agents, other conditioning agents, thickening agents, oxidation dyes, and direct dyes. See Dubief at column 7, line 50 to column 8, line 14. Dubief discloses an extensive list of cationic polymers, surfactants, reducing agents, fixing agents, neutralizing agents, thickening agents, and other conditioning agents. Dubief at columns 7-9.

The Office's rejection is improperly predicated on selecting and combining isolated teachings from Dubief when the reference itself provides no motivation for the combination. The mere fact that a reference can be modified does not render the modification obvious unless the prior art suggests the desirability of the modification. See MPEP § 2143.01. To reach Applicants' claimed invention from Dubief's disclosure, one would have to choose: (1) a specific cationic polymer (for example, claims 46 and 47) from an extensive laundry list of cationic polymers; (2) to add a dye to Dubief's conditioner; (3) a specific thickener from a long list of possible thickeners many of which are not presently claimed; and then (4) to combine all three. Dubief itself provides no guidance for such a combination, and in fact teaches away from such a combination. Dubief's only dyeing example (Example 6) is already in thickened cream form. Dubief, while disclosing thickeners as possible ingredients, teaches that its oxidative dyeing compositions do not require additional thickening agents. As such, one skilled in the art would have been discouraged from adding a thickener. Therefore, there is no motivation in the reference to add any thickener, let alone a *specific* thickener, to such a composition.

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The Office urges that a reference is not limited to its working examples. This may be so, but the remainder of the reference provides no motivation or guidance to modify its teaching. If the only guidance the reference provides teaches away from the proposed modification, one cannot ignore such guidance arbitrarily.

Dubief's disclosure of additional ingredients does not necessarily suggest that all of the ingredients may be used in combination. For example, the reference discloses acidifying agents and alkalinizing agents. One would certainly not use both of these together; their properties would counter-act. Similarly, just because thickeners and dyes happen to be mentioned separately as possible ingredients, does not necessarily suggest combining thickeners and dyes.

Moreover, Applicants' invention is reached only by employing impermissible hindsight. For example, for instant claim 47, one would first have to choose Group 7 from Dubief's extensive list of cationic polymers, then one would have to limit the molecular weight to about 1200 when the reference is silent regarding molecular weight,<sup>1</sup> then one would have to add a dye, and finally one would have to choose NATROSOL PLUS from a long list of thickeners and add it to the dye and polymer when the only dyeing example in Dubief would guide one away from thickening such a dyeing composition. Applicants submit that these choices could have been made only using Applicants' own

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<sup>1</sup>Dubief's Example 6 discloses a poly(quaternary ammonium) cationic polymer, but it fails to mention the molecular weight thereof.

specification as a guide. This is clearly improper. See MPEP § 2143, *supra*. For at least the reason that the reference lacks the motivation for and teaches away from Applicants' claimed invention, the rejection is improper. Accordingly withdrawal of this rejection is respectfully requested.

### CONCLUSION

In view of the foregoing remarks, Applicants submit that the claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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